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Reconsideration of the application in view of the following amendments and remarks is respectfully requested.

### REMARKS

#### **STATUS OF APPLICATION**

No new claims have been added and no claims have been canceled. Accordingly, claims 1-30 are pending in the present application. Claims 17-20 stand withdrawn from consideration.

#### **DRAWINGS**

The Office Action fails to indicate whether the drawings are accepted by the Examiner. Such an indication is again respectfully requested.

#### **ALLOWABLE SUBJECT MATTER**

The indication in the Office Action that claims 21-27 are allowed is acknowledged with appreciation. Further, the indication that claims 3, 4, 6, 8-16, 29, and 30 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims is also noted with appreciation. Claims 12 and 13, however, are independent claims. Claims 14-16 depend from claim 13. Accordingly, Applicant asserts that claims 12-16 are now allowed (rather than being allowable if rewritten in independent form). Such an indication on the record is respectfully requested. Claims 3, 4, 8-11, 29, and 30 have not been

rewritten in independent form as Applicant asserts the independent claims from which they depend are in condition for allowance.

### 35 USC § 102 REJECTION

The rejection of claims 1, 2, 5, 7, and 28 as being anticipated by US 3,193,013 to Whiteside (hereinafter referred to as "the Whiteside patent") is respectfully traversed for the reasons set forth hereinafter.

Claim 1 requires a first member, a second member releasably attached to the first member, and a control line shear mechanism disposed proximate an interface between the first member and the second member. The Whiteside patent discloses a sleeve 66 that fits around a lower section 20 of a body 10.<sup>1</sup> The Office Action alleges that the sleeve 66 is the claimed first member and that the lower section 20 is the claimed second member. The Whiteside patent teaches that the sleeve 66 is held in a position with respect to the lower section 20 by two set screws 68.<sup>2</sup> However, the Whiteside patent is silent with regard to the sleeve 66 being releasably attached to the lower section 20, as required by claim 1. Further, the Whiteside patent fails to disclose or suggest any way of releasing the sleeve 66 from the lower section 20, or that releasing the sleeve 66 from the lower section 20 would be desirable or would serve any purpose. Rather, releasing the sleeve 66 from the lower section 20 would cause the sleeve 66 to no longer be positioned in front of the knife 50, rendering the Whiteside device inoperable, as the line 14 is cut against the sleeve 66.<sup>3</sup>

<sup>1</sup> See column 3, lines 49-50, of the Whiteside patent.

<sup>2</sup> See column 3, line 56, of the Whiteside patent.

<sup>3</sup> See column 3, lines 57-58, of the Whiteside patent.

*Not weeded  
"releasable"*

Claim 1 is anticipated by the Whiteside patent, "[o]nly if each and every element as set forth in the claim is found, either expressly or inherently described" in a single prior art reference."<sup>4</sup> Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim."<sup>5</sup> The Whiteside patent, however, falls short of these requirements.

Further, the Whiteside patent fails to render the present invention, as set forth in claim 1, obvious. To establish a *prima facie* case of obviousness, three basic criteria must be met<sup>6</sup>:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, rather than merely in Applicants' disclosure, to modify the reference or to combine reference teachings;
- (2) There must be a reasonable expectation for success found in the prior art, rather than in Applicants' disclosure; and
- (3) The prior art references must teach or suggest all the claim limitations.

The Whiteside patent fails to disclose or suggest the sleeve 66 being releasably attached to the lower portion 20. Rather, the Whiteside patent teaches away from such a configuration, as discussed above. As the Whiteside patent is silent with regard to the sleeve 66 being releasably attached to the lower portion 20, it cannot provide a reasonable expectation of success of such a configuration. Further, as discussed above, the Whiteside patent does not disclose or suggest all of the limitations of claim 1. Accordingly, the present invention, as set forth in claim 1, is allowable over the Whiteside patent.

Claims 2, 5, and 7 depend from claim 1. Accordingly, the remarks provided above concerning claim 1 apply equally to claims 2, 5, and 7.

<sup>4</sup> See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>5</sup> See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 28 recites attaching a control line to a tubular string comprising a safety sub. The Whiteside patent fails to disclose or suggest attaching the wireline 14 to the body 10 in any way. Tubing Rather, the Whiteside patent teaches that the body 10 is dropped within the tubing 64 with the wings 12 partially surrounding the wireline 14. The wireline 14 is drawn taut so that the body 10 makes a free fall along the wireline 14 to the bottom of the well. The free fall of the body 10 continues until the bottom of the body 10 strikes the tool on the bottom of the wireline 14. This impact fires the cartridge 26, thus causing the knife 50 to cut the wireline 14.<sup>7</sup> Accordingly, the Whiteside patent fails to disclose attaching the control line (*i.e.*, the wireline 14) to the body 10 and, thus, cannot anticipate the present invention, as set forth in claim 28.

Further, the Whiteside patent cannot render the present invention, as set forth in claim 28, obvious. If one skilled in the art were to attach the wireline 14 to the body 10, the body 10 could not be dropped so as to fall along the wireline 14. So modifying the Whiteside patent would prevent the body 10 from operating as taught by the Whiteside patent. Accordingly, the present invention, as set forth in claim 28, is allowable over the Whiteside patent.

Therefore, it is respectfully requested that the rejection of claims 1, 2, 5, 7, and 28, as being anticipated by the Whiteside patent, be reconsidered and withdrawn.

### CONCLUSION

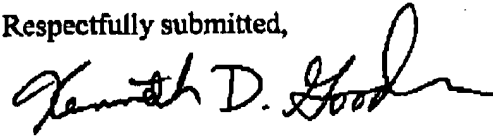
Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to contact Daren C. Davis at

<sup>6</sup> See MPEP 2143 and *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>7</sup> See column 3, lines 15-32, of the Whiteside patent.

(817) 578-8616 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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March 12, 2003